REMARKS/ARGUMENTS:

Claims 24 and 25 have been amended to correct dependency.

Claims 4, 5, 13, 14, 17 and 21 stand withdrawn

Claims 1 – 37 are in the case.

No new matter has been added.

Rejection of claims 24 and 25 under 35 USC §112, second paragraph, as being indefinite.

Claims 24 and 25 were rejected as being indefinite on account of a lack of antecedent basis for the terms "the insect" in line 1 of each claim. The dependency of claims 24 and 25 has been amended so that proper antecedent basis for the terms "the insect" is provided by the claim from which they depend. It is respectfully requested, therefore, that this rejection be reconsidered and withdrawn.

Rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20 and 22 – 37 under 35 USC §112, first paragraph, as lacking sufficient written description for the terms "additional pesticide".

The Office has asserted a ground of rejection under 35 USC §112, 1st paragraph, lack of description, for claims 1 – 3, 6 – 12, 15, 16, 18 – 20, 22 – 37 based on undue experimentation required to identify "additional pesticides", and also that claims lack critical steps.

With respect, the feature that is described in the rejected claims is not simply an "additional pesticide", but is "... if the seed is treated with a pesticide in addition to the pyrethrin or synthetic pyrethroid, the additional pesticide is added as a part of the composition along with the pyrethrin or synthetic pyrethroid."

Accordingly, the "additional pesticide" that is referred to in the claimed element can be any pesticide, but the claim limitation is directed not to the interaction of the additional pesticide with the pyrethrin or synthetic pyrethroid, but to how an additional pesticide, no matter what it is, is added to the composition. It is maintained that one of ordinary skill in the art of seed treatment would readily understand the meaning of this feature. It is believed, therefore, that the present claims meet all written description requirements under 35 USC §112, first paragraph, and it is respectfully requested that the present ground of rejection be reconsidered and be withdrawn.

Rejection of claims 1 – 3, 6 and 25 – 27 under 35 USC §103(a) as being obvious over the Gatehouse *et al.* article.

It is respectfully requested that the rejection of claims 1 – 3, 6 and 25 – 27 under 35 USC §103(a) as being obvious over the Gatehouse *et al.* article be reconsidered and be withdrawn for the reasons discussed below.

The Office has argued that the article by Gatehouse *et al.* teaches a method of applying permethrin to wheat seed to protect wheat from damage by wheat bulb fly larvae, and that permethrin has a vapor pressure that is lower than that of tefluthrin. The Office admits that the article fails to teach the control of cutworm damage and the rate of application of permethrin to the seed that is required in the present claims, but argues that it would have been obvious to determine the optimum application rate of permethrin to the seed in order to determine what application rate is effective at controlling pests while at the same time promoting healthy plant growth. The Office then argues that "it is possible that artisan would have discovered that instant application rate is most effective".

Initially, it is noted that the mere possibility that an artisan would have discovered the claimed invention does not rise to the level necessary to support a *prima facie* obviousness rejection.

Furthermore, while the present claims require that "...if the seed is treated with a pesticide in addition to the pyrethrin or synthetic pyrethroid, the additional pesticide is added as a part of the composition along with the pyrethrin or synthetic pyrethroid", the Gatehouse *et al.* reference clearly states that its winter wheat seeds were "pre-treated with a liquid organomercury fungicide ('Panogen M') at 0.75 ml kg^{-1}", and "...then treated with ...permethrin..." (last line on page 110, continuing to page 111). Because the prior art provides no suggestion or motivation to combine the fungicide treatment with the pyrethrin/pyrethroid treatment, as the present claims require, the Gatehouse *et al.* reference cannot teach or make obvious the claimed invention.

Accordingly, it is respectfully requested that the present ground of rejection be reconsidered and withdrawn.

Rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20 and 22 – 35 on the ground of nonstatutory obviousness-type double patenting over claims 1, 3, 26, 28, 29, 31 – 35 and 41 – 48 of U.S. Patent No. 6,660,690.

A terminal disclaimer is attached in favor of the 6,660,690 patent.

Rejection of claims 1, 9 – 12, 15, 16, 18, 19 and 24 on the ground of nonstatutory obviousness-type double patenting over claims 1 – 4, 7, 14 – 16, 18 – 21, 24 – 29 and 31 of U.S. Patent No. 6,713, 077.

The Office has argued that the cited claims of the `077 patent teach the application of a composition comprising permethrin and an additional insecticide to seeds in order to protect developing plants from damage by pests. The Office admits that the cited claims are silent as to the rate of application of the permethrin to seed, but argue that one of ordinary skill would have been motivated to determine the optimum application rate in order to determine what rate is effective at controlling pests while at the same time promoting healthy plant growth. The Office concludes that "it is possible that artisan would have discovered that instant application rate is most effective."

It must be noted that in addition to silence regarding the application rate of pyrethrins, the cited claims are also silent regarding the present claim feature that "... if the seed is treated with a pesticide in addition to the pyrethrin or synthetic pyrethroid, the additional pesticide is added as a part of the composition along with the pyrethrin or synthetic pyrethroid.

In order to make the presently claimed invention obvious, the Office must show that at least one examined application claim is not patentably distinct from the referenced claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the referenced claim(s). *Eli Lilly & Co. v. Barr Labs., Inc.,* 58 USPQ2d 1869 (Fed. Cir. 2001).

Because the referenced claims of the `077 patent do not teach each and every feature of the present claims, they cannot anticipate those claims. Furthermore, because the reference claims do not disclose or suggest the features of the present claims involving the rate of application or the application of an additional pesticide along with the purethrin/pyrethroid, they cannot form the basis of a *prima facie* case of

obviousness. Accordingly, it is respectfully requested that the present ground of nonstatutory double patenting over the `077 patent be reconsidered and be withdrawn.

Rejection of claims 1 – 3, 6 – 8 and 37 on the ground of nonstatutory obviousness-type double patenting over claims 1, 3 and 8 – 10 of U.S. Patent No. 6,903,093.

A terminal disclaimer is attached in favor of the 6,903,093 patent.

Provisional rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20, 22, 23 and 25 – 35 on the ground of nonstatutory obviousness-type double patenting over claims 9 – 13 and 15 – 23 of copending U.S. Patent Application No. 11/072,215.

It is respectfully requested that prosecution of the present claims continue until a provisional double patenting rejection based on a co-pending application such as the application noted above is the only remaining ground of rejection, and that rejection should then be withdrawn pursuant to MPEP §804(I)(B).

Provisional rejection of claims 1 – 3, 6 – 12, 15, 16, 18 – 20, 22, 23 and 25 – 35 on the ground of nonstatutory obviousness-type double patenting over claims 1 and 9 – 25 of copending U.S. Patent Application No. 11/028,782.

It is respectfully requested that prosecution of the present claims continue until a provisional double patenting rejection based on a co-pending application such as the application noted above is the only remaining ground of rejection, and that rejection should then be withdrawn pursuant to MPEP §804(I)(B).

Election status:

The comment regarding the non-allowability of the elected invention is noted.

Request for reconsideration:

It is respectfully requested that the claims be reconsidered in view of the amendments and the reasons that are discussed above and be found to be allowable. If one or more of the claims are found to not be allowable, a telephone call to the undersigned would be appreciated in order to resolve any remaining issues.

Respectfully requested,

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